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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/730,117	12/09/2003	Sugio Makishima	2091-0304P	4321

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EXAMINER	
BEMBEN, RICHARD M	

ART UNIT	PAPER NUMBER
2622	

NOTIFICATION DATE	DELIVERY MODE
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

mailroom@bskb.com

Office Action Summary	Application No. 10/730,117	Applicant(s) MAKISHIMA ET AL.	
	Examiner Richard M. Bemben	Art Unit 2622	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/219,123.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>12/9/03, 8/10/06</u> | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Specification

1. Amendment submitted 19 November 2004 is acknowledged and accepted.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. **Claims 1, 2, 3/1, 3/2, 5-7 and 9-11 are rejected under 35 U.S.C. 102(e) as being anticipated by Nishitani et al. (US 5,966,553), hereafter "Nishitani".**

Regarding **claim 1**, Nishitani discloses a digital camera (c. 4, ll. 20-27; Figs. 1-3) comprising:

display means for displaying digital image data as a photographed image, the digital image data being acquired by photographing (c. 4, l. 63 – c. 5, l. 20; Figs. 1-3, "12");

printing-specifying information setting means for setting printing specifying information for said digital image data, the printing specifying information being used during printing (c. 8, l. 5 – c. 9, l. 50; c. 11, l. 17 – c. 12, l. 8; Figs. 5A-C and 7A-D);

and control means for displaying said digital image data for which said printing-specifying information was set onto said displaying means so that said printing-specifying information corresponds to said digital image data (c. 6, ll. 41-52; Fig. 3, "22", "44", "45"; c. 8, l. 5 – c. 9, l. 50; c. 11, l. 17 – c. 12, l. 8; Figs. 5A-C and 7A-D).

Regarding **claim 2**, refer to the rejection of claim 1 and Nishitani further discloses that said printing-specifying information during said printing includes a number of print sheets (c. 8, l. 29; c. 9, ll. 28-38; Figs. 5A, 7A, 7D), specification of an index image, printing size (c. 8, l. 28 – c. 9, l. 22; Figs. 5A-C and 7A-D), surface treatment, presence of a white frame, trimming and/or attribute data (claim 2 is examined in the alternative form; c. 8, l. 5 – c. 9, l. 50; c. 11, l. 17 – c. 12, l. 8; Figs. 5A-C and 7A-D).

Regarding **claim 3/1 and 3/2**, refer to the rejection of claim 1 or 2 and Nishitani further discloses that control means is means for displaying digital image data with said printing-specifying information and digital image data with no printing-specifying information so that they are discriminated from each other, when they are displayed on said display means (c. 6, ll. 40-52; c. 9, ll. 39-50; c. ll. 36-59).

Regarding **claim 5**, refer to the rejection of claim 1 and Nishitani further discloses that said control means is means for displaying said digital image data for which said printing-specifying information was set onto said display means in display form corresponding to said printing-specifying information (refer to the rejection of claim 1).

Regarding **claim 6**, refer to the rejection of claim 1 and Nishitani further discloses that said control means is means for displaying a total number of print sheets on said display means, when said printing-specifying information during said printing includes a number of print sheets (c. 8, l. 29; c. 9, ll. 28-38; Figs. 5A, 7A, 7D).

Regarding **claim 7**, refer to the rejection of claim 1 and Nishitani further discloses that said control means is means for displaying a number of print frames on said display means, when said printing-specifying information during said printing includes said number of print sheets (c. 8, ll. 51; Figs. 5A-C and 7A-D, "55").

Claim 9 is a method claim corresponding to apparatus claim 1. Therefore, claim 9 is analyzed and rejected as previously discussed with respect to claim 1.

Claim 10 is a method claim corresponding to apparatus claim 2. Therefore, claim 10 is analyzed and rejected as previously discussed with respect to claim 2.

Regarding **claim 11**, refer to the rejection of claim 9 and Nishitani further disclose displaying a sum of print sheets (claim 11 is examined in the alternative form; c. 8, l. 29; c. 9, ll. 28-38; Figs. 5A, 7A, 7D).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. **Claims 4/1, 4/2, 8 and 12 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishitani in view of Hanzawa (US 5,506,661).**

Regarding **claims 4/1 and 4/2**, Nishitani discloses a digital camera comprising a display that displays print information (refer to the rejections of claims 1 and 2).

However, Nishitani does not disclose that control means is means for displaying only the printing-specifying data for which said printing-specifying information was set, in displaying said digital image data on said display means.

Hanzawa discloses a digital camera comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that only the printing-specifying data is displayed on said display means (Figs. 2, 5, 6, 8).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to only display print-specifying data as disclosed by Hanzawa on the display means disclosed by Nishitani in order to simplify the display or save power.

Regarding **claim 8**, Nishitani discloses a digital camera comprising a display that displays print information (refer to the rejection of claim 1). However, Nishitani does not disclose that control means is means for displaying a printing price value corresponding

to the number of print sheets onto said display means, when said printing-specifying information during said printing includes said number of print sheets.

Hanzawa discloses a digital camera comprising a display that displays print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses that the display displays a printing price value corresponding to the number of print sheets onto said display means, when said printing-specifying information during said printing includes said number of print sheets (c. 4; ll. 40-63; c. 6, l. 3 – c. 7, l. 28; Figs. 2, 5, 6, 8). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to display a printing price value corresponding to the number of print sheets as disclosed by Hanzawa on the display means disclosed by Nishitani in order to inform the customer of the printing price (which is well-known at photo kiosks and the like).

Regarding **claim 12**, Nishitani discloses a method of displaying print information (refer to the rejection of claim 9). However, Nishitani does not disclose the step of setting an upper limit value of a total number of print sheets to be used in printing.

Hanzawa discloses a method of displaying print information (c. 3, ll. 23-25; c. 4, ll. 40-63; Fig. 2). Hanzawa further discloses setting an upper limit value of a total number of print sheets to be used in printing (c. 5, ll. 46-65; Fig. 6). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to set an upper limit value as disclosed by Hanzawa in the method of displaying print information

disclosed by Nishitani in order to set different unit prices for different ranges of the number of prints.

Double Patenting

6. Applicant is advised that should claim 1 be found allowable, claim 5 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim.

See MPEP § 706.03(k).

7. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

Claim 12 is rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 3, 4, and 5 of prior U.S. Patent No. 6,686,964. This is a double patenting rejection.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kawamura et al. (US 6,522,354) discloses an electronic camera that displays recorded information, such as image frames, to permit the selection of items of information to be transferred to external equipment.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard M. Bemben whose telephone number is (571) 272-7634. The examiner can normally be reached on 8:30AM-5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lin Ye can be reached on (571) 272-7372. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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